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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,389	08/15/2003	Jay Fraleigh	040292.003	9489
25461	7590	05/19/2004	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592				ALIMENTI, SUSAN C
ART UNIT		PAPER NUMBER		
		3644		

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/642,389	FRALEIGH ET AL. <i>b6</i>
	Examiner	Art Unit
	Susan C. Alimenti	3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 August 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 14-18, 20 and 21 is/are rejected.
- 7) Claim(s) 12-15 and 17-21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1-9, drawn to a planting bed and method for making the same, classified in class 47, subclass 58.1SC.
 - II. Claims 22-25, drawn to an apparatus for making a planting bed, classified in class 47, subclass 32.2.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus for making a planting bed could be used to lay any type of material not specifically a weed barrier and also the planting bed can be made by hand.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I and vice versa, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Eric Hanson on 14 May 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-25 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

6. New corrected drawings are required in this application should allowable subject matter be found present because the present drawings are informal in nature and are not acceptable for patent publication. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

7. Claims 14-15, 17-18, 20-21 are objected to because of the following informalities:

- Claims 14, 17-18, and 20-21 are directed to “a planting bed”, however they are dependent upon a method claim

- Claim 15, similarly is directed to a method, however it is dependent upon an product claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "the spray emitter " in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-10, 14-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird (US 5,709,049), and further in view of Billings (US 6,223,466).

Baird discloses the claimed invention except the plant is not placed in a plant container before being inserted into the ground. Baird's ground cover method comprises creating a raised planting bed 46, covering the same with a water-permeable weed barrier 80, inserting a hole 88

into said barrier 80. Baird further teaches that his system can be utilized to surround various objects or plants other than those shown in the figures (Baird, col.6, lns.35-40). Billings discloses an alternate planting system comprising a double container setup that is embedded in a hole in the ground. Billings' system allows the user to easily interchange plant containers by removing container 12 from container 20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Billing's planting system with Baird's ground cover in order to allot the user the versatility to change the plants being displayed.

Regarding claim 2, Baird's system comprises an individual directed water line 100.

Regarding claims 3, 6, 14, the container 50 in Billings' device (Figure 1-2) is considered to be the root deterrent material wrapped about plant container 12.

Regarding claims 4-5, 9, the water line 100 is considered to serve the dual purpose of water supply and temperature control, since water is a known coolant and the introduction of such would affect the temperature of the plant bed 46. Furthermore Baird discloses the that the hose 100 may be in many different forms including but not limited to drip irrigation (Baird, col.5, lns.30-32)

Regarding claims 7, 15-17, 20, Baird's device is considered to have a spray emitting function since water line 100 is provided with holes 104, and the form of the water output is merely dependent on water pressure

Regarding claims 8, 18, and 21, Baird, as modified, disclosed water line 100 affixed to planting bed 46, which is considered to be a container holding the container plant therein.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baird in view of Billings as applied to claim 10 above, and further in view of Nir et al. (US 4,437,263).

Baird, as modified, discloses the claimed invention except there is no temperature controlling line beneath the weed deterring material for controlling the bed temperature. Nir et al. (Nir hereafter) teaches the use of an underground heating system, comprising lines 21 that run just below the root system of plants and provide heated water to the ground surface. This upwelling of thermal energy controls the temperature of the ground surface and prevents cold damage to the root systems. Further, it is usable in any agricultural application. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Nir's system with Baird's system in order to prevent cold damage to root systems.

Allowable Subject Matter

13. Claims 12-13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T. Jordan can be reached on 703-306-4159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA

Charles T. Jordan
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